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Andreas Eipper

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CONNOLLY BOVE LODGE & HUTZ LLP

1875 EYE STREET, N.W.

SUITE 1100

WASHINGTON, DC 20006

EXAMINER

LEE, DORIS L

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PAPER NUMBER

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,998	<b>Applicant(s)</b> EIPPER ET AL.	
	<b>Examiner</b> Doris L. Lee	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 8, 2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-3 and 6-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gareiss et al (US 5,712,336)** in view of **Dvornic et al (US 2002/0161113)**.

**Regarding claims 1, 14-17**, Gareiss teaches a thermoplastic molding composition (Abstract), comprising

- A) from 10% to 97.9% by weight of at least one thermoplastic polyester (col. 1, line 8), and
- C) from 0 to 70% by weight of other additives (col. 1, lines 16-17).

However Gareiss does not teach that the thermoplastic molding composition further comprises a component

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- B) at least one highly branched or hyperbranched polyester of  $A_xB_y$  type, where  $x$  is at least 1.1 and  $y$  is at least 2.1, or a mixture of these,

Dvornic teaches a hyperbranched polyester of the  $A_xB_y$  type (Abstract) where  $x$  is at least 1.1 and  $y$  is at least 2.1 ([0007]). Dvornic teaches that A and B are different monomers ([0006]) and that  $x$  and  $y$  are the number of functional groups present in A and B ([0012]). Dvornic teaches that the degree of branching is from 25% to 55 % ([0024]). Dvornic teaches that the hyperbranched polyester has both structural and molecular non-uniformity (see the structures on page 2). Dvornic also teaches that polymer compositions comprising highly branched polyester have a lower viscosity and better shear thinning properties for applications than similar compositions containing a chemically similar linear polyester ([0002]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the hyperbranched polyester of Dvornic to the composition of Gareiss. One would have been motivated to do so in order to receive the expected benefit of controlling and changing the ease of processability of the polyester material (Dvornic [0002]). They are combinable because they are concerned with the same field of endeavor, namely thermoplastics. Absent objective evidence to the contrary and based upon the teachings of the prior art, there would have been a reasonable expectation of success.

As to the amount of the hyperbranched polyester, it is the examiner's position that it is a result effective variable because changing them will clearly affect the type of product obtained. See MPEP § 2144.05 (B). Case law holds that "discovery of an

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optimum value of a result effective variable in a known process is ordinarily within the skill of the art.” See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In view of this, it would have been obvious to one of ordinary skill in the art to utilize appropriate amounts of hyperbranched polyester to achieve the desired processability of the thermoplastic, including those within the scope of the present claims, so as to produce desired end results.

Modified Gareiss also does not explicitly teach the amounts of each component as recited in the instant claim, however, given that modified Gareiss teaches ranges which overlap significantly with the claimed amounts, it would have been obvious, based on the teachings of the prior art to use amounts of the components that are well within the range of the claimed invention as it is well settled that where the prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir. 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

Gareiss fails to explicitly teach the OH number and the COOH number of component B, however, it discloses a highly branched or hyperbranched polyester of  $A_xB_y$  type, where x is at least 1.1 and y is at least 2.1 (Dvornic, [0007]). It is therefore inherent that the highly branched polyester of modified Gareiss since such a property is evidently dependent upon the nature of the composition used. Case law holds that a

material and its properties are inseparable. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

**Regarding claim 2 and 18-19**, modified Gareiss teaches that the polymer has a molar mass of about 1,000 to 10,000 (Dvornic, [0024]).

**Regarding claims 3 and 6**, modified Gareiss discloses the hyperbranched polyester as recited in the instant claims above, it is therefore inherent that the hyperbranched polyester has the corresponding glass transition temperature, the OH number and the COOH number as recited in the instant claims since such a property is evidently dependent upon the nature of the composition used. Case law holds that a material and its properties are inseparable. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

**Regarding claims 7-11**, modified Gareiss teaches a method of obtaining the hyperbranched polyester using the methods recited in the instant claims in which multifunctional alcohols are reacted with multifunctional carboxylic acids (Dvornic, [0014]). As the synthesis of these compounds elucidated in modified Gareiss will result in the same structural compositions as presently claimed, the method of synthesis is does not confer patentability to the claims, as these claims 7-11 are product-by-process claims, patentability of said claim is based on the recited product and does not depend on its method of production. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

**Regarding claims 12 and 13**, modified Gareiss discloses all the limitations as set forth above.

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In addition, modified Gareiss teaches that a fiber, foil or molding can be made (Gareiss, col. 9, lines 63-64) via injection molding (Gareiss, col. 10, lines 36-37).

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Double patenting 1***

5. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1, 9 and 10** of copending **Application No. 10/587,997** in view of **Dvornic et al (US 2002/016113)**.

Claims 1, 9 and 10 of ‘997 teach a thermoplastic polyester with a hyperbranched polycarbonate and other additives, but fails to teach the hyperbranched polyester.

Dvornic teaches a hyperbranched polyester of the A<sub>x</sub>B<sub>y</sub> type ([0008]) where x is at least 1.1 and y is at least 2.1 ([0007]). Dvornic also teaches that polymer

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compositions comprising highly branched polyester have a lower viscosity and better shear thinning properties for applications than similar compositions containing a chemically similar linear polyester ([0002]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the hyperbranched polyester of Dvornic to the composition of '997. One would have been motivated to do so in order to receive the expected benefit of controlling and changing the ease of processability of the polyester material (Dvornic [0002]). They are combinable because they are concerned with the same field of endeavor, namely thermoplastics. Absent objective evidence to the contrary and based upon the teachings of the prior art, there would have been a reasonable expectation of success.

This is a provisional obviousness-type double patenting rejection.

6. Claims 1-3 and 6-19 are directed to an invention not patentably distinct from claims 1, 9 and 10 of commonly assigned copending Application 10/587,997. Specifically, see discussion set forth in paragraph 5 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 10/587,997, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can,



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under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 2***

7. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12, 13, and 17-21** of copending Application **No. 11/576,646**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9, 12 and 13 of Application '646 recite a thermoplastic polymer, and a highly branched polyester. However, the claims of App '646 fail to teach that the thermoplastic polymer is polyester.

The specification of App '646 teaches that the thermoplastic polymer can be polyester (page 3, line 8-10).

Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970). Therefore, it would have been obvious to one of ordinary skill in the art to use polyester in the

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specification as the thermoplastic polymer in the claims of App '646 to arrive at the present invention.

Although it is noted that the copending application contains additional ingredient(s) not explicitly present in the instant claims, nevertheless, given that both sets of claims are recited in open language (cf. comprising) so that the present claims are open to the inclusion of additional unrecited ingredients, the overlap in scope supports and warrants the instant rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-3 and 6-19 are directed to an invention not patentably distinct from claims 1, 5-9, 12, 13 and 17-21 of commonly assigned copending Application 11/576,646. Specifically, see discussion set forth in paragraph 7 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/576,646, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 3***

9. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 11, 12, 15, 16, and 20-21** of copending Application **No. 11/577,009**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9, 11, 12, 15, 16 20-21 of Application '009 recite all the components of the instant claims. Because the instant claimed invention is encompassed by the copending application, it would have been obvious to one of ordinary skill in that art at the time of the invention to use all the components of copending App '009 in a composition to arrive at the presently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-3 and 6-19 are directed to an invention not patentably distinct from claims 1, 5-9, 11, 12, 15, 16, and 20-21 of commonly assigned Application 11/577,009. Specifically, see discussion as set forth in paragraph 9 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/577,009, discussed above, would

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form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 4***

11. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1, 5-9, 12-13, and 16-20** of copending **Application No. 11/577,587** in view of **Dvornic et al (US 2002/016113)**.

Claims 1, 5-9, 12-13, and 16-20 of '587 teach a thermoplastic polyester with a hyperbranched polycarbonate and other additives, but fails to teach the hyperbranched polyester.

Dvornic teaches a hyperbranched polyester of the  $A_xB_y$  type ([0008]) where x is at least 1.1 and y is at least 2.1 ([0007]). Dvornic also teaches that polymer compositions comprising highly branched polyester have a lower viscosity and better

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shear thinning properties for applications than similar compositions containing a chemically similar linear polyester ([0002]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the hyperbranched polyester of Dvornic to the composition of '587. One would have been motivated to do so in order to receive the expected benefit of controlling and changing the ease of processability of the polyester material (Dvornic [0002]). They are combinable because they are concerned with the same field of endeavor, namely thermoplastics. Absent objective evidence to the contrary and based upon the teachings of the prior art, there would have been a reasonable expectation of success.

This is a provisional obviousness-type double patenting rejection.

12. Claims 1-3 and 6-19 are directed to an invention not patentably distinct from claims 1, 5-9, 12-13 and 16-20 of commonly assigned Application 11/577,587.

Specifically, see the discussion set forth in paragraph 11 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/577,587, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions

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were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 5***

13. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12-13, 17-21** of copending Application **No. 11/577,590**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9, 12-13, 17-21 of Application '590 recite all the components of the instant claims. Because the instant claimed invention is encompassed by the scope of the copending application, it would have been obvious to one of ordinary skill in that art at the time of the invention to use all the components of copending App '009 in a composition to arrive at the presently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 1-3 and 6-19 are directed to an invention not patentably distinct from claims 1, 5-9, 12-13 and 17-21 of commonly assigned Application 11/577,590. Specifically, see the discussion as set forth in paragraph 13 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/577,590, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 6***

15. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 6-11, and 13-14** of copending Application **No. 11/632,711**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 6-11, and 13-14 of Application '711 recite all the components of the instant claims. Because the instant claimed invention is encompassed by the copending application, it would have been obvious to one of

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ordinary skill in that art at the time of the invention to use all the components of copending App '009 in a composition to arrive at the presently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1-3 and 6-19 are directed to an invention not patentably distinct from claims 1, 6-11 and 13-14 of commonly assigned Application 11/632,711. Specifically, see the discussion as set forth in paragraph 15 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/632,711, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 7***



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17. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, and 15-16** of copending Application **No. 11/659,506**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9 and 15-16 of Application '506 recite all the components of the instant claims. Because the instant claimed invention is encompassed by the scope of the copending application, it would have been obvious to one of ordinary skill in that art at the time of the invention to use all the components of copending App '009 in a composition to arrive at the presently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claims 1-3 and 6-19 directed to an invention not patentably distinct from claims 1, 5-9 and 15-16 of commonly assigned application 11/659.506. Specifically, see the discussion as set forth in paragraph 17 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/659,506, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions

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were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 8***

19. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9 and 12-13** of copending Application **No. 11/659,625**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9 and 12-13 of Application '625 recite all the components of the instant claims. Because the instant claimed invention is encompassed by the copending application, it would have been obvious to one of ordinary skill in that art at the time of the invention to use all the components of copending App '009 in a composition to arrive at the presently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

20. Claims 1-3 and 6-19 are directed to an invention not patentably distinct from claims 1, 5-9 and 12-13 of commonly assigned application 11/659,625. Specifically, see the discussion as set forth in paragraph 19 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned application 11/659,625, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 9***

21. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **14, 19-23 and 25** of copending Application **No. 11/813,638**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14, 19-23 and 25 of Application '638 recite all the components of the instant claims. Because the instant claimed invention is encompassed by the copending application, it would have been obvious to one of

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ordinary skill in that art at the time of the invention to use all the components of copending App '009 in a composition to arrive at the presently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

22. Claims 1-3 and 6-19 directed to an invention not patentably distinct from claims 14, 19-23 and 25 of commonly assigned application 11/813,638. Specifically, see the discussion as set forth in paragraph 21 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned application 11/813,638, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 10***

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23. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **14, 19-23 and 25** of copending Application **No. 11/813,833**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14, 19-23 and 25 of Application '833 recite all the components of the instant claims. Because the instant claimed invention is encompassed by the copending application, it would have been obvious to one of ordinary skill in that art at the time of the invention to use all the components of copending App '009 in a composition to arrive at the presently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

24. Claims 1-3 and 6-19 directed to an invention not patentably distinct from claims 14, 19-23 and 25 of commonly assigned application 11/813,833. Specifically, see the discussion as set forth in paragraph 23 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 11/813,833, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were

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commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 11***

25. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12-13, and 16-20** of copending Application **No. 11/996,489**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9, 12-13, 16-20 of Application '489 recite all the components of the instant claims. Because the instant claimed invention is encompassed by the copending application, it would have been obvious to one of ordinary skill in that art at the time of the invention to use all the components of copending App '009 in a composition to arrive at the presently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

26. Claims 1-3 and 6-19 are directed to an invention not patentably distinct from claims 1, 5-9, 12-13 and 16-20 of commonly assigned application 11/996,489. Specifically, see the discussion as set forth in paragraph 25 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned application 11/996,489, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 12***

27. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9 13-14, and 18-20** of copending Application **No. 11/815,238**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9 13-14, 18-20 of Application '238 recite all the components of the instant claims. Because the instant claimed invention is encompassed by the copending application, it would have been obvious to one of

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ordinary skill in that art at the time of the invention to use all the components of copending App '009 in a composition to arrive at the presently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

28. Claims 1-3 and 6-19 directed to an invention not patentably distinct from claims 1, 5-9, 13-14 and 18-20 of commonly assigned application 11/815,238. Specifically, see discussion as set forth in paragraph 27 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned application 11/815,238, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

### ***Response to Arguments***



29. The double patenting rejections are again set forth in the above office action. It is noted that applicant requests that these rejections are to be held in abeyance until allowable subject matter is indicated. However, these rejections cannot be suspended without persuasive arguments to overcome the rejection. As such, the double patenting rejections are maintained and set forth above.

30. Applicant's arguments filed April 8, 2009 have been fully considered but they are not persuasive for the reasons set forth below:

31. **Applicant's argument:** Gareiss only describes thermoplastic polyesters with conventional additives and there is no such description or suggestion of modifying the reference with any expected benefit to include a highly branched polyester.

**Examiner's response:** *As Gareiss is open to additional additives, it is open to modification by the secondary references, Dvornic and/or Brenner. It is these secondary references which provide the teaching and motivation for modifying Gareiss with the highly branched or hyperbranched polymers. The fact that Gareiss does not mention highly branched or hyperbranched polymers cannot overcome the prima facie case of obviousness because one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).*

32. **Applicant's argument:** In addition, Dvornic provides no indication of the development of a composition containing the polymers or any indication that one would substitute the thermoplastic polymer of Gareiss for a highly branched one.

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**Examiner's response:** *Dvornic teaches in paragraph [0002] of its specification that highly branched polymers are used in polymer compositions to change the physical characteristics of the composition. The examiner does not propose substituting the polymer of Gareiss for a highly branched polymer, rather, the examiner set forth a prima facie case for using the hyperbranched polymer as the additive in the composition of Gareiss.*

33. **Applicant's argument:** Dvornic does not show the limitations of the newly amended claim.

**Examiner's response:** *All the new limitations have been addressed in new rejections set forth above.*

34. **Applicant's argument:** The examiner used improper hindsight reasoning to combine the references to arrive at the present invention.

**Examiner's response:** *In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).*

### **Conclusion**

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35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796

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